

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Tameka Spence, et al. Art Unit 1731
Serial No. 10/039,237
Filed December 31, 2001
Confirmation No. 7293
For PROCESS FOR MANUFACTURING A CELLULOSIC PAPER PRODUCT EXHIBITING
REDUCED MALODOR

September 6, 2006

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS,
SIR:

LETTER TO PATENT AND TRADEMARK OFFICE

In response to the Notice of Allowance dated July 20, 2006, in the above-referenced patent application, applicants respectfully request reconsideration of the patent term adjustment determination. Pursuant to 37 CFR § 1.705(b) and/or (d), applicants submit the following statement of facts in support of this request for reconsideration:

1. The Office issued a Notice to File Missing Parts of Nonprovisional Application on February 4, 2002. Applicants responded on May 31, 2002, which is twenty-seven **(27)** days more than the three (3) month period for response.
2. On May 22, 2003 the Office issued a non-final Office action. Applicants responded to this action on July 21, 2003, which is within the three month shortened statutory period for response. A supplemental Information Disclosure Statement was filed on July 21, 2003 and received in the Office on July 23, 2003. According to the Patent Application Information Retrieval (PAIR) database there was applicant delay of two (2) days, stretching from the day after the response to the non-final Office action was filed to the day the

supplemental Information Disclosure Statement was received in the Office.

It appears the Office is considering the supplemental information disclosure statement to be a supplemental reply to the May 22, 2003 Office action. As established in 37 C.F.R. §1.704(c)(8), submission of a supplemental reply after a reply has been filed is a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. However, applicants respectfully submit that the supplemental information disclosure statement is not a supplemental reply, as mentioned in 37 C.F.R. §1.704(c)(8).

Initially, applicants note that the supplemental information disclosure statement at issue was not submitted for purposes of supplementing an Office action response. Rather, this supplemental information disclosure statement was submitted merely to report references of which applicants had become aware, in compliance with applicants duty of disclosure under 37 C.F.R. 1.97 and 1.98. It is thus respectfully submitted that applicants should not be penalized by losing patent term, simply because applicants were attempting to comply with the duty of disclosure under 37 C.F.R. 1.97 and 1.98.

Furthermore, even if the supplemental Information Disclosure Statement is considered a supplemental reply to the May 22, 2003 Office action, applicants again note that the supplemental Information Disclosure Statement was received in the Office on July 23, 2003, which is within three months of the mailing date of the May 22, 2003 Office action. As such, even if the supplemental Information Disclosure Statement is considered a reply to the Office action, it would not constitute applicant delay. See 37 C.F.R. §1.704(b).

3. The Office issued another non-final Office action on May 11, 2004. Applicants responded on August 9, 2004, which is within the three month shortened statutory period for response. On December 9,

2004 the Office mailed an Abandonment notice for failure to respond to the Office action. Applicants filed a petition to withdraw the holding of abandonment on December 17, 2004, which is within two months of the mailing of the notice of abandonment.¹ A decision granting the petition to withdraw the holding of abandonment was issued on May 23, 2005.²

In PAIR, the response to the May 11, 2004 Office action has been given a date of February 17, 2004. PAIR furthermore lists the delay on the part of applicant as one hundred ninety (190) days, stretching from the day after the date that is three months after the date the non-final Office action was mailed (i.e., May 11, 2004) to February 17, 2005, the date the response to the non-final Office action was given in PAIR. However, as noted above, the response to the May 11, 2004 Office action was actually filed on August 9, 2004³ (which is within the three month shortened statutory period for response), not February 17, 2004. Since a response was filed within three months of the mailing date of the Office action, applicants submit that there is no applicant delay in responding to the May 11, 2004 Office action.

Additionally, as noted above, the petition to withdraw the holding of abandonment was filed on December 17, 2004, which is within two months from the mailing date of the notice of abandonment (i.e., December 9, 2004). As such, there is no applicant delay resulting from the filing of the petition to withdraw the holding of abandonment.⁴

4. As noted above, PAIR incorrectly indicates that the response to the May 11, 2004 Office action was filed on February 17, 2005. The Office issued the subsequent Office action on September 8, 2005. Thus,

¹ Applicants also resubmitted a copy of the petition on February 17, 2005.

² A second decision granting the petition was issued on June 17, 2005.

³ In the decisions granting withdrawal of the holding of abandonment, the Office recognizes that a reply was properly filed on August 9, 2004. It appears the date of response is incorrectly listed in PAIR as February 17, 2005.

⁴ According to 37 C.F.R. §1.704(c) (4) failure to file a petition to withdraw the holding of abandonment within two months from the mailing date of a notice of

according to PAIR, there is Office delay of eighty-three (83) days, stretching from the day after the date that is four months from the date the response to the May 11, 2004 Office action was submitted (i.e., February 17, 2005 according to PAIR) to the day the subsequent Office action was mailed (i.e., September 8, 2005). However, as noted above, the response to the May 11, 2004 Office action was actually filed on August 9, 2004. The Office did not reply until August 8, 2005, which is two hundred forty-two **(242)** days after the four (4) month period for reply by the Office. Applicants thus submit that the Office delay is actually two hundred forty-two **(242)** days.

5. The Office mailed a final Office action on January 31, 2006. Applicants responded to this action on March 30, 2006, which is within the three month period for response. The Office issued an Advisory Action on April 6, 2006, and applicants filed a response to the Advisory Action on May 1, 2006. According to PAIR, the filing of this response constituted applicant delay of one **(1)** day.

6. Based on the above recited facts, the delay on the part of the Office was two hundred forty-two **(242)** days. The delay on the part of Applicants was twenty-eight **(28)** days. The result is a patent term adjustment of two hundred fourteen **(214)** days.

7. Applicants note that the Office delay set forth above was calculated under 37 C.F.R. §1.702(a). However, according to 37 C.F.R. §1.702(b), the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application as filed under 35 U.S.C. §111(a) (i.e., December 31, 2001), with the period of adjustment being the number of days in the period beginning on the day after the date that is three years after the

abandonment constitutes a failure of an applicant to engage in reasonable efforts to

filing date (i.e., December 31, 2004). Although applicants do not yet know the date the application will issue, it is noted that the amount of Office delay calculated under 37 C.F.R. §1.702(b) will be more than two hundred forty-two (242) days.⁵ As such, it is applicants' intention to request a correction of patent term adjustment, based on Office delay as calculated under 37 C.F.R. §1.702(b), once the application issues.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No. 19-1345. However, in view of the fact that the Office made a mistake in calculating the correct patent term adjustment, applicants respectfully request that the fee in connection with this request be waived.

Respectfully Submitted,



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By EFS

conclude examination of an application.

⁵ Applicants note that the application was not the subject of a Request for Continued Examination under 35 U.S.C. §132(b) or an interference proceeding, was not maintained in a sealed condition under 35 U.S.C. §181, and was not the subject of an appeal to the Board of Patent Appeals and Interferences.